REMARKS

In response to the present Office Action, the Examiner rejected claims 1-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,670,207 ("the '207 patent"). Applicant respectfully traverses the rejections based on the '207 patent. However, in the interest of expediting the issuance of the patent and to address the rejections based on the '207 patent, Applicant has included herewith a Terminal Disclaimer under 37 C.F.R. § 1.321, Statement under 37 C.F.R. § 3.73(b), establishing the right of the Assignee to take action, and a check in the amount of $130 for the fee required by 37 C.F.R. § 1.20(d).

Applicant respectfully submits that the filing of the Terminal Disclaimer effectively addresses the Examiner's rejections of claims 1-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of the '207 patent.

In the present Office Action, the Examiner also rejected claims 1-7, 11, 12, 13, 14, 15, and 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,803,579, issued to Turnbull et al. ("the '579 patent"). Applicant respectfully traverses this rejection. Section 35 U.S.C. § 102(b) requires that "[a] person shall be entitled to a patent unless...the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." Applicant submits that this rejection is improper here because the '579 patent did not issue until *after* the filing date of U.S. Patent No. 6,132,072 ("the '072 patent") from which the current application receives its priority date. Specifically, the filing date for the '072 patent was September 4, 1998. The '579 patent did not issue until September 8, 1998, four days after the filing date of the '072 patent. Because the '579 patent did not issue more than one year prior to the current application's priority date of September 4, 1998, the rejection under paragraph (b) of 35 U.S.C. § 102 is improper.

Nevertheless, the '579 patent might be considered prior art under 35 U.S.C. § 102(e). Under Section 35 U.S.C. § 102(e)(2), a person is entitled to a patent unless "the invention was described in...a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent...." The Examiner argues that claims 1-7, 11, 12, 13, 14, 15, and 19 are anticipated by the '579 patent. Accepting this as true only for the purpose of argument, and treating the '579 patent as § 102(e) prior art, this objection can be overcome by establishing that the '579 application was not filed in the United States before the invention by the Applicant of the present invention.

Prior invention can be established by a showing of constructive reduction to practice. According to MPEP § 2138.05, "reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed. The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. Thus, the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application."

Here, the inventor of the claimed invention, John Roberts, was also an inventor on the '579 patent. The Examiner states that claims 1-7, 11, 12, 13, 14, 15, and 19 are anticipated by the '579 patent. Assuming, arguendo, that this is true, by filing the patent application in the '579 patent on June 13, 1996, John Roberts established a date of constructive reduction to practice of not later than June 13, 1996, for claims 1-7, 11, 12, 13, 14, 15, and 19 of the present invention, according to MPEP § 2138.05. Accordingly, assuming June 13, 1996, is the date of constructive reduction to practice for claims 1-7, 11, 12, 13, 14, 15 and 19 of the present invention, then the '579 patent, with a filing date of June 13, 1996, was not "...filed in the United States before the invention by the applicant for patent...," and cannot serve as disqualifying prior art under Section 35 U.S.C. § 102(e). To establish the date of constructive reduction to practice discussed above, Applicant has enclosed a Declaration under 37 C.F.R. § 1.131, signed by the inventor of the present invention, John K. Roberts.

Applicant further notes that PCT application WO 97/48134 corresponds to the '579 patent (a copy of which is enclosed). The above argument would apply should the Examiner decide to use WO 97/48134 as prior art under Section 35 U.S.C. § 102(a) as a basis for finding claims 1-7, 11, 12, 13, 14, 15 and 19 to be anticipated. Because WO 97/48134 was not published until December 18, 1997, later than the date of constructive reduction to practice outlined above, it cannot be said, as is required by § 102(a), that the invention was "...patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant...."

Applicant submits that the Declaration under 37 C.F.R. § 1.131, in combination with the above arguments, removes any possible objections under §§ 102(a) or 102(e) using the '579 patent or WO 97/48134 as a basis to reject claims 1-7, 11, 12, 13, 14, 15, and 19 of the present invention.

In the present Office Action, the Examiner also rejected claims 8, 9, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over the '579 patent, as applied to claims 1-6, 11, 12, and 13 above, and further in view of Gardner et al. Applicant respectfully traverses this rejection because it is improper.

The '579 patent does not qualify as prior art under paragraphs (a) and (b) of § 102. Thus, Applicant submits that the '579 patent can only serve as a basis for rejection under § 103(a) here, if it is prior art under § 102(e). However, 35 U.S.C. § 103(c) applies in this case to remove this possible basis for rejection. 35 U.S.C. § 103(c) states that "subject matter developed by another person which qualifies as prior art only under one or more of subsections (e), (f), and (g) of § 102 of this Title shall not preclude patentability under this section where the subject matter and the claimed invention were at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person." Here, the subject matter and the claimed invention were at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person or organization. Therefore, the '579 patent cannot be used as § 102(e) prior art to support a § 103(a) rejection of claims 8, 9, 16, and 17.

To the extent the Examiner may find that WO 97/48134 might serve as § 102(a) prior art for purposes of a § 103(a) rejection, Applicant relies on the Declaration under 37 C.F.R. § 1.131 that establishes a constructive reduction to practice for the present invention of no later than June 13, 1996. Because this constructive reduction to practice predated the publication date of WO 97/48134, it establishes an earlier date of invention and serves to remove any potential § 103(a) rejections using WO 97/48134 as § 102(a) prior art.

In the present Office Action, the Examiner also rejected claims 10 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the '579 patent as applied to claims 1-6, 11, 12, and 13 above. For the same reasons stated above, Applicant respectfully traverses this rejection because it is improper.

Because the subject matter and the claimed invention were at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person or organization, the '579 patent cannot qualify as § 102(e) prior art in support of a § 103(a) obviousness rejection.

As noted above, it is possible that WO 97/48134 might serve as § 102(a) prior art to support a § 103(a) obviousness rejection. However, Applicant has included Declaration under 37 C.F.R. § 1.131 stating that John K. Roberts constructively reduced the current invention to practice by June 13, 1996. Because this constructive reduction to practice establishes a date of invention prior to the publication of WO 97/48134 application, WO 97/48134 cannot serve as § 102(a) prior art to support a § 103(a) obviousness rejection.

Applicant respectfully submits that, based on the above discussion, the filing of the Terminal Disclaimer, the filing of the Statement under 37 C.F.R. § 3.73(b), and the filing of the Declaration under 37 C.F.R. § 1.131, the application is now in condition for allowance.

Applicant submits that this Reply is fully responsive to the above-referenced Office Action.

CONCLUSION

If the Examiner has any questions or comments with respect to this Reply, the Examiner is invited to contact the undersigned at 616/949-9610.

Respectfully submitted,

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